REMARKS

Applicants wish to extend their gratitude to the Examiner, Raquel Alvarez, for her courtesies extended during the interview conducted on July 20, 2004, and for her assistance in advancing the prosecution on the merits of the present application.

During the interview, independent claim 15 was discussed. An agreement was reached that unamended independent claim 15, which was presented prior to the interview, distinguished over the *Cannon* reference. A demonstration of the claimed invention was also presented to the Examiner during the interview. The following amendments and remarks discuss and expand upon the substance of the material discussed during the interview.

In the Response to Restriction Requirement filed October 31, 2003, Applicants stated "a proper examination of Group III, claims 15-16 would require a search of the method of Group VI, claims 21-22." During the interview, the Examiner agreed that Group III, claims 15-16 and Group VI, claims 21-22 should be in combined in the same group. As a result, Applicants have represented claims 21 and 22 for prosecution on the merits. These claims have also been amended along the lines of claims 15 and 16.

Claims 15, 16, and 27-39 are pending. The Specification has been amended. The Abstract of the Disclosure has been amended. The drawings have been amended. Claims 15, 16, 21, 22, and 28-39 have been amended. New claims 40-89 have been added. No new matter has been added by way of these amendments. Reconsideration of the application is respectfully requested.

In amending claims 15 and 21, they were broadened to allow the ad server to maintain any ad, not just a targeted ad. Further, data store and match maker were broadened so they could operate on any content of the retrieved information and not particular content. As originally presented, these claims recited the rules which indicated relevancy of the ad to a content and parsing the content, without defining the source of the content. Thus, the claims were amended to recite explicitly what was inherent in the claim, i.e., the content discussed was that retrieved by the user station. See *TurboCare v. Gen. Elec. Co.*, 264 F.3d 1111 (Fed. Cir. 2001). See also *Bose Corp. v. JBL, Inc.* 274 F.3d 1354 (Fed. Cir. 2001) and *Interactive Pictures Corp. v. Infinite Pictures, Inc.* 274 F.3d 1371 (Fed. Cir. 2001).

Claims 15, 16, 27, and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by WO 99/46719 to *Cannon*, while claims 29-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Cannon* in view of U.S. Patent No. 5,835,087 to *Herz* et al., claims 33 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Cannon* in view of U.S. Patent No. 5,636,346 to *Saxe*, and claims 35-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Cannon* in view of U.S. Patent No. 5,930,764 to *Melchione* et al. Applicants respectfully submit that all claims of record distinguish over the cited references.

The present invention relates generally to providing content, services and advertising about services by means of the Internet and, more particularly, to bringing to customers various services, content, advertising about services and affiliate links that are automatically determined to be relevant to the customer's current interest on the Internet (see page 1, line 17 thru page 2, line 2 of the specification).

WO 99/46719 to *Cannon* relates to a method and apparatus for quickly and easily analyzing large quantities of computer-based media-related data. According to this publication, the data can be manipulated to evaluate, score and optimize an advertising campaign by interactively comparing many different options. According to this publication, the most preferred embodiment is a computer-based decision support system that includes three main components: a database mining engine (DME); an advertising optimization mechanism; and a customized user interface that provides access to the various features associated with the system. (See page 6 line 15 thru page 7, line 7).

However, Applicants respectfully assert that this reference fails to teach the invention described by claim 15. That is, *Canon* fails to teach "an ad server which maintains the ads for the user at the station across the distributed computer network, the user station allowing the user to retrieve information containing content; a data store that identifies a set of rules associated with each ad, the rules indicate a level of relevancy of the ad to the content of the information; and a match maker that accesses the content retrieved by the user, extracts that content according to its rules, parses the content of the information by objects and targets an ad from the server to the content by applying the rules in the data store, and that directly sends the ad to the station for display," as set forth in claim 15. Accordingly, Applicants respectfully assert that claim 15 is patentable over the *Canon* reference, and reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

U.S. Patent No. 5,835,087 to *Herz* et al. relates to a system that automatically constructs both a "target profile" for each target object in the electronic media based, for example, on the frequency with which each word appears in an article relative to its overall frequency of use in all

articles, as well as a "target profile interest summary" for each user. According to this patent, the target profile interest summary describes the user's interest level in various types of target objects (see col. 1, lines 27).

Set forth on page 3 thru 4 of the Office Action is the statement that:

> *Herz* is considered to disclose the claimed structural relationship of *at least one multiple keyword purchased by an advertiser* (column 15 lines 1-56) for targeted advertising for a price (column 16 line 65). (Emphasis Added)

With respect to the foregoing, the *Herz* et al. patent was introduced to reject application claims 29-32 based on its combination with the *Cannon* publication. However, Applicants respectfully assert that the *Herz* et al. patent fails to cure the deficiencies of the *Cannon* publication and hence, these claims are also patentable over the combination of the *Cannon* and *Herz* et al. references. Specifically, *Herz* et al. also fails to teach the limitations set forth in amended claims 15 or 21 from which claims 22 or 29-32 depend.

With reference to col. 55, lines 45-59, the *Herz* et al. patent describes a news clipping service; that is:

> [a] system for customized electronic identification of desirable objects of the present invention can be used in the electronic media system of FIG. 1 to implement an automatic news clipping service which learns to select (filter) news articles to match a user's interests, based solely on which articles the user chooses to read.

As described in col. 55, lines 50-54 of the *Herz* et al. patent:

> The system for customized electronic identification of desirable objects *generates a target profile for each article that enters the electronic media system*, based on the relative frequency of occurrence of the words contained in the article. (Emphasis Added)

The generation of the target profile for each article that enters the electronic media system is described in detail in col. 56, lines 37-47 of the *Herz* et al. patent as follows:

> The article profile module 201 of the system for customized electronic identification of desirable objects can reside on the information server S_4 and operates pursuant to the steps illustrated in the flow diagram of FIG. 5, where, as each article is received at step 501 by the information server S_4, the article profile module 201 at step 502 *generates a target profile for the article and stores the target profile in an article indexing memory* (typically part of mass storage system SS_4 for later use in selectively delivering articles to users. (Emphasis Added)

Col. 55, lines 59-63 of the *Herz* et al. patent further states:

> As new articles are received for storage on the mass storage systems SS_1-SS_m of the information servers I_1-I_m, the system for customized electronic identification of desirable objects generates their target profiles.

In the invention defined by amended claim 15, on the other hand, a match maker is used to access content retrieved by the user, extract that content based on its rules, and parse the content of the information according to the objects in the content. That is, the match maker of the present invention parses the content of a user's current page being viewed, groups attributes to form structured objects, communicates with a rules registry and produces a set of contextually relevant advertisements or affiliate links in response thereto (see page 26, lines 19-23 of the specification). The *Herz* et al. patent fails to teach this aspect of the claimed invention.

As stated in col. 55, lines 54-59 of the *Herz* et al. patent:

> The system for customized electronic identification of desirable objects also *generates a search profile set for each user, as a function of the target profiles of the articles the user has accessed and the relevance feedback the user has provided on these articles*. (Emphasis Added)

The generation of search profiles is described in detail in col. 56, lines 16-30 as follows:

> The news clipping service instantiates target profile interest summaries as search profile sets, so that a set of high-interest search profiles is stored for each user. The search profiles associated with a given user change over time. As in any application involving search profiles, they can be initially determined for a new user (or explicitly altered by an existing user) by any of a number of procedures, including the following preferred methods: *(1) asking the user to specify search profiles directly by giving keywords and/or numeric attributes, (2) using copies of the profiles of target objects or target clusters that the user indicates are representative of his or her interest, (3) using a standard set of search profiles copied or otherwise determined from the search profile sets of people who are demographically similar to the user.* (Emphasis Added)

In the present claimed invention, however, no search profiles for users are generated. Rather, the match maker set forth in amended claims 15 and 21 identifies the objects and attributes which are mentioned on a page. The attributes belonging to a particular object are then grouped together. For example, a page may mention several computers and for each computer, it may mention attributes such as brand, processor type, and processor speed. The match maker, as set forth in claim 15, will group together the attributes belonging to each computer object and produce a list of computer objects found on the page (see 27, lines 13-19).

The use of the target profiles of the *Herz* et al. patent is described in col. 55, lines 63-65 as follows:

> The generated target profiles are later compared to the search profiles in the users' search profile sets, and those new articles whose target profiles are closest (most similar) to the closest search profile in a user's search profile set are identified to that user for possible reading.

The *Herz* et al. patent describes this in col. 57, lines 21-27 as follows:

> The user has a search profile set stored in the local data storage medium on the proxy server S_2. When the user requests access to "news" at step 1102, the profile matching module 203 resident on proxy server S_2 sequentially considers each search profile P_k from

> the user's search profile set to determine which news articles are most likely of interest to the user.

The presentation of the list of articles to the user is stated in col. 58, lines 27-30 as follows:

> At step 1104 the profile processing module 203 stores a list of the identified articles for presentation to each user....

As further described in col. 58, lines 45-56:

> The user can then transmit a request by computer, facsimile, or telephone to indicate which of the identified articles the user wishes to review, if any. The user can still access all articles in any information server S_4 to which the user has authorized access, however, those lower on the generated list are simply further from the user's interests, as determined by the user's search profile set. The server S_2 retrieves the article from the local data storage medium or from an information server S_4 and presents the article one screen at a time to the user's client processor C_1. The user can at any time select another article for reading or exit the process.

With respect to the foregoing steps, the match maker described in claim 15 is not used to compare generated target profiles to a search profiles in a user's search profile set. It is based on the content of the page. In addition, the match maker does not present a list of articles to the user based on those news articles having target profiles that are closest (most similar) to the closest search profile in the user's target profile set, after which the user can transmit a request to indicate which of the articles the user wishes to review. Rather, as described on page 26, lines 21-23 of the specification, the match maker parses the content of the user's current page being viewed, groups attributes to form structured objects, communicates with a rules registry, and produces a set of contextually relevant advertisements or affiliate links in response thereto. The *Herz* et al. patent fails to describe a match maker that performs in the manner set forth in amended claim 15 and hence, for this additional reason it fails to cure the deficiency of the *Cannon* publication.

In col. 55, line 66 to col. 56, line 5, the *Herz* et al. describe monitoring articles that are read by the user as follows:

> The computer program providing the articles to the user *monitors how much the user reads* (the number of screens of data and the number of minutes spent reading), and *adjusts the search profiles* in the user's search profile set to more closely match what the user apparently prefers to read. (Emphasis Added)

The monitoring steps are described in detail in col. 58, lines 58-65 of the *Herz* et al. patent, wherein:

> The user's search profile set generator 202 at step 1107 monitors which articles the user reads, keeping track of how many pages of text are viewed by the user, how much time is spent viewing the article, and whether all pages of the article were viewed.

The adjustment of the user search profiles disclosed in *Herz* et al. is described in col. 59, lines 14-18, wherein:

> When an article is read, the server S_2 shifts each search profile in the set slightly in the direction of the target profiles of those nearby articles for which the computed measure of article attractiveness was high.

With respect to the foregoing, Applicants respectfully assert that using a computer program to monitor how much the user reads, i.e., the number of screens of data and the number of minutes spent reading, and adjusting the user's search profiles fails to render claims 15 or 21 obvious over the combination of the *Cannon* and *Herz* et al. references. The claimed invention is directed to providing a user with ads that are relevant to the current page being viewed. The claimed invention is achieved in real time, as opposed to the off-line processes that are disclosed in the *Cannon* or *Herz* et al. references. Therefore, for at least this additional reason, Applicants

respectfully assert that amended independent claims 15 and 21 are patentable over the combination of the *Cannon* or *Herz* et al. references.

In col. 56, lines 6-14, the *Herz* et al. patent also states that:

> This method requires selecting a specific method of calculating user-specific search profile sets, of measuring similarity between two profiles, and of updating a user's search profile set (or more generally target profile interest summary) based on what the user read....

Claim 15 includes the limitation:

> *a match maker that accesses the content retrieved by the user, extracts that content according to its rules, parses the content of the information by objects and targets an ad to the content by applying the rules in the data store, and that directly sends the targeted ad to the station for display.*

With respect to the foregoing limitation of claim 15, Applicants respectfully assert that the *Hertz* et al. patent fails to disclose "a match maker that accesses the content retrieved by the user, extracts that content according to its rules, parses the content of the information by objects, targets the ad to the content by applying the rules in the data store, and directly sends the targeted ad to the station for display."

The method described in the *Herz* et al. patent includes steps to i) initialize users search profile sets (col. 56, lines 15); ii) retrieve new articles from [an] article source (col. 56, line 2); iii) calculate article profiles (col. 56 line 3); iv) compare current articles' target profiles to a user's search profiles (col. 57, lines 9-10); v) present a list of articles to user (col. 58, line 26); vi) monitor which artciles are read (col. 58, line 57); and vii) update user profiles (col. 59, line 11) to ensure that the user is presented with a listing of articles most likely to be of interest to the user.

In contrast, the match maker set forth in amended claim 15 analyzes the content on any web page and finds an ad which is targeted for that content, irregardless of whether the user has

looked at that content and what their past desire to view the content is. The *Herz* et al. reference fails to teach this aspect of the claimed invention. As a result, for at least this reason, Applicants respectfully assert that amended claim 15 is patentable over the *Herz et al.* patent. Accordingly, Applicants respectfully assert that the rejection of claims 29-32 based on the combination of the *Cannon* and *Herz* et al. references should be withdrawn, and a notice to that effect is earnestly solicited.

U.S. Patent No. 5,636,346 to *Saxe* discloses a process for directing different commercial messages, advertisements and programming to different demographically and selectively targeted television audiences by relating carrier subscriber data to other proprietary marketing databases (see col. 1, lines 9-13).

Set forth on page 4 of the Office Action is the statement that:

> *Saxe* is considered to disclose the claimed *content portion on the distributed network requested by the user* (column 4 lines 18-54). (Emphasis Added)

With respect to the foregoing, the *Saxe* patent was introduced to reject application claims 33 and 34 based on its combination with the *Cannon* publication. Applicants respectfully assert that the *Saxe* patent fails to cure the deficiencies of the *Cannon* publication and hence, these claims are also patentable over the combination of the *Cannon* and *Saxe* references. Specifically, *Saxe* also fails to teach the limitations set forth in amended claims 15 or 21 from which claims 33 and 34 depend. Accordingly, Applicants respectfully assert that the rejection of claims 33 and 34 based on the combination of the *Cannon* and *Saxe* references should be withdrawn, and a notice to that effect is earnestly solicited.

U.S. Patent No. 5,930,764 to *Melchione* et al. relates to an electronic sales and service support system and a method for assisting customer service and identifying sales targets, distributing sales leads, enhancing sales tools, and tracking performance of sales and sales personnel (see col. 1, lines 25-31).

Set forth on page 4 thru page 5 of the Office Action is the statement that:

> Melchione is considered to disclose the claimed *content classification related to past consumption through an affiliate network* (column 13 line 62 through column 14 line 64 wherein the disclosed micromarketing center is considered patentably equivalent to the claimed affiliate network because both provide the same result in the same manner using the same means) in real time or prior user operation time of the distributed computer network (column 8 lines 4-10). (Emphasis Added)

With respect to the foregoing, the *Melchione* et al. patent was introduced to reject application claims 35-39 based on its combination with the *Cannon* publication. Applicants respectfully assert that the *Melchione* et al. patent fails to cure the deficiencies of the *Cannon* publication and hence, these claims are also patentable over the combination of the *Cannon* and *Melchione* et al. references. Specifically, *Melchione* et al. also fails to teach the limitations set forth in amended claim 15 from which claims 35-39 depend. Accordingly, Applicants respectfully assert that the rejection of claims 35-39 based on the combination of the *Cannon* and *Melchione* et al. references should be withdrawn, and a notice to that effect is earnestly solicited.

In sum, whether considered individually or in combination, the references fail to teach or suggest the invention set forth in amended independent claim 15, i.e., "an ad server which maintains the ads for the user at the station across the distributed computer network, the user station allowing the user to retrieve information containing content; a data store that identifies a set of rules associated with each ad, the rules indicate a level of relevancy of the ad to the content of the

information; and a match maker that accesses the content retrieved by the user, extracts that content according to its rules, parses the content of the information by objects and targets the ad to the content by applying the rules in the data store, and that directly sends the targeted ad to the station for display." Accordingly, independent claim 15 is patentable over the combination of the *Cannon*, *Herz* et al., *Saxe*, and *Melchione* et al. references.

In view of the patentability of amended independent claims 15 and 21, for the reasons above, dependent claims 16, 22, 27-39, new dependent claims 40-88, as well as new independent claim 89 are all patentable over the prior art.

Based on the foregoing amendments and remarks, this application should be in condition for allowance. Early passage of this case to issue is respectfully requested. However, if there are any questions regarding this Response, or the application in general, a telephone call to the undersigned would be appreciated since this would expedite the prosecution of the application for all concerned.

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Respectfully submitted,

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Attachments

ANNOTATED SHEET SHOWING CHANGES

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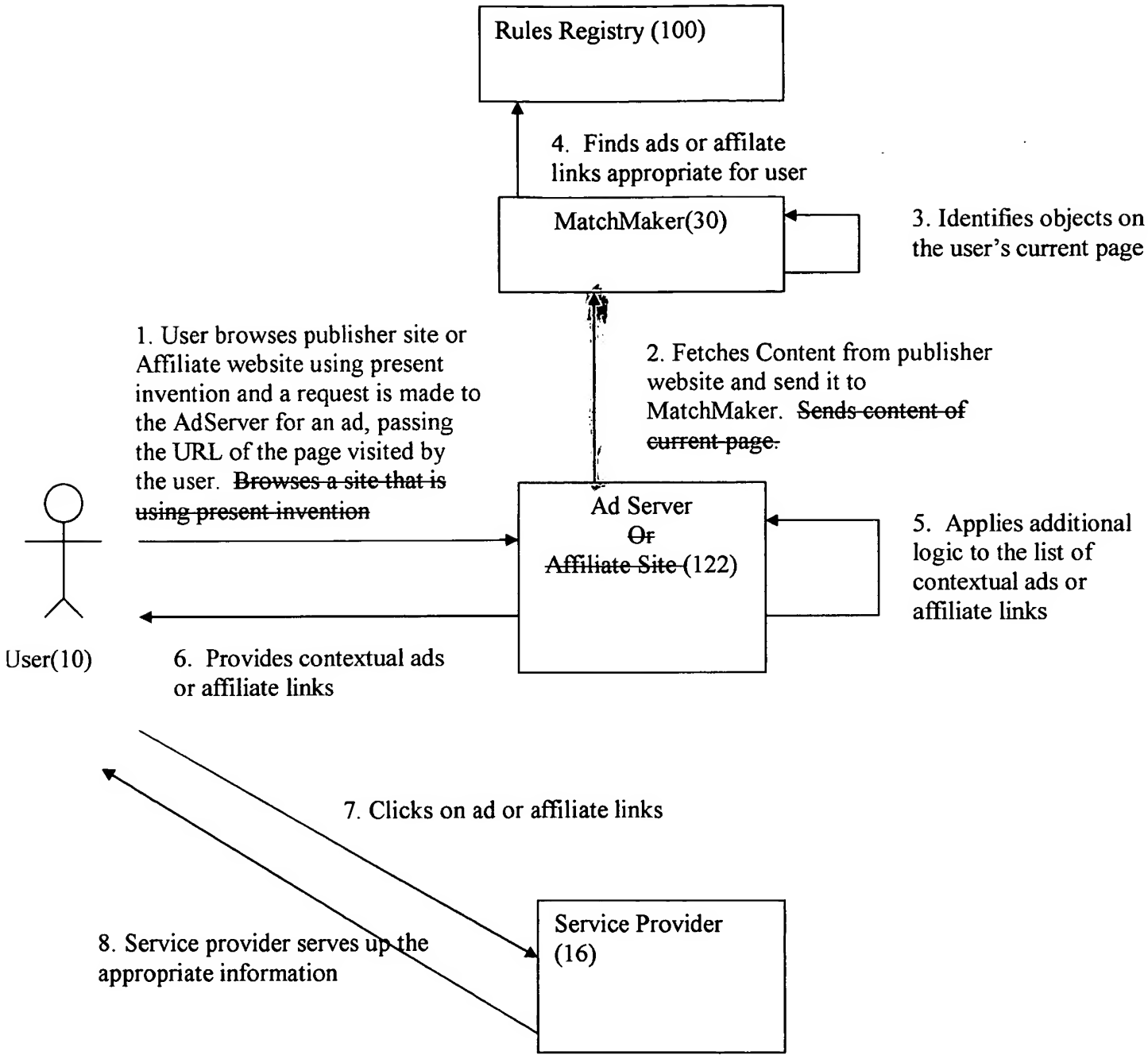

Figure 10